

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion is respectfully requested.

Claims 2, 3, 5-20, 22-32, 40 and 42-55 are pending in the case. Claims 2, 22 and 40 are amended; and Claim 4 is canceled by the present amendment. Support for amended Claims 2, 20, 22 and 40 can be found in the original specification, claims and drawings.¹ No new matter is presented.

In the outstanding Official Action, Claims 2-20, 22-40, and 42-55 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of copending Application 09/684,965 filed October 10, 2000 (hereinafter, "the '965 application") in view of Navarre et al. (U.S. Patent 6,442,611, hereinafter "Navarre"); and Claims 2-20, 22-40 and 42-55 were rejected under 35 U.S.C. § 103(a) as unpatentable over Navarre in view of Miller et al. (U.S. Patent No. 5,475,819, hereinafter "Miller").

As the outstanding obviousness-type double patenting rejection is provisional in nature, Applicants respectfully request that this rejection be held in abeyance until the substantive merits of the presently pending case (as well as the '965 application) are addressed. At which time Applicants maintain the right to file a terminal disclaimer against the '965 application to obviate the outstanding obviousness-type double patenting rejection.

The undersigned appreciatively acknowledge the courtesy extended by Examiner Nguyen by holding a personal interview with the undersigned on January 13, 2005. During the interview an overview of the present invention was presented, and the pending claims were discussed in light of the applied references. The substance of the interview is reflected in amended Claims 2, 22 and 40, as discussed below. No agreement was reached during the interview pending a formal response to the outstanding Official Action.

¹ Specification at Figs. 5A-5C and 6, for example.

The Official Action has rejected Claims 2-20, 22-40 and 42-55 under 35 U.S.C. § 103 as unpatentable over Navarre in view of Miller. The Official Action cites Navarre as disclosing the Applicants' invention with the exception of selecting an application service provider (ASP). The Official Action cites Miller as disclosing this limitation and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the reference teachings.

Applicants respectfully submit that amended independent Claims 2, 22 and 40 state novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 2 recites, *inter alia*, a method for managing ASP transactions between an ASP and an ASP user, comprising:

- ...determining whether a document profile exists for said user identifier received, ***said document profile indicating at least one available ASP configured to perform document management;***

- sending to said user a document manager interface screen based on said determination of whether a document profile exists, said document manager interface screen indicating the at least one available ASP indicated by the document profile;

- selecting an ASP for processing said transaction request from said document manager interface screen; and

- transmitting instructions for performing said transaction request, via said communications network, to said selected ASP.

Independent Claims 22 and 40 are directed to alternative statutory embodiments, but recite substantially similar features as recited in amended independent Claim 2. Accordingly, the arguments presented below are applicable to each of amended independent Claims 2, 22 and 40.

Turning to the applied primary reference, Navarre describes a method and gateway for gaining access to a plurality of local criminal record databases.² Navarre describes that a user, by way of a client application (410), submits user authentication information and search request information to a gateway (420), which formats and transmits the data to the

² Navarre at Fig. 3.

database(s) (430-460) for processing.³ The database(s) then return a response based on the received information, which is formatted by the gateway (420) to be displayed to the user at the client application.⁴

Navarre, however, fails to teach or suggest determining whether a document profile exists for a received user identifier, *said document profile indicating at least one available ASP configured to perform document management*, as recited in amended independent Claim 2.

At col. 4, lines 56-60, Navarre describes that once user authentication is complete, a user profile is used to create a menu of services accessible for the client for that session. Specifically, Navarre's menu indicates the various local law enforcement databases (e.g., Du Page County, Kane County, etc.) available for keyword searching by a user. However, these local law enforcement databases simply store information related to individuals, and do not perform any *document management* services whatsoever, and, therefore, are not analogous to the ASP(s) recited in the claims. Thus, Navarre describes that a user profile exists, but fails to teach or suggest determining that a *document profile indicating at least one available ASP which is configured to perform document management* exists for a received user identifier, as recited in amended independent Claim 2.

Amended independent Claim 2 further recites sending to said user a document manager interface screen indicating the at least one available ASP, selecting an ASP for processing a transaction request from the document manager interface screen, and transmitting instructions for performing said transaction request to the selected ASP. As discussed above, Navarre fails to teach or suggest determining that a document profile exists indicating at least one available ASP *configured to perform document management*.

³ Navarre at col. 2, lines 50-65.

⁴ Id.

Therefore, Navarre also fails to teach or suggest the sending, selecting and transmitting steps, all which discuss the use of the ASP, as recited in amended independent Claim 2.

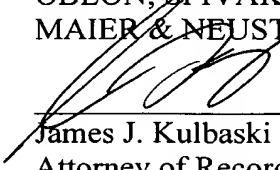
As discussed above, Navarre fails to teach or suggest determining that a ***document profile indicating at least one available ASP which is configured to perform document management*** exists for a received user identifier. Likewise, Miller fails to remedy this deficiency, and therefore, none of the cited references, alone or in combination teach or suggest Applicants' Claims 2, 3, 5-20, 22-40, and 42-55 which include the above distinguished limitation by virtue of independent recitation or dependency. Therefore, the Official Action fails to provide a *prima facie* case of obviousness with regard to any of these claims.

Accordingly, Applicant respectfully requests the rejection of Claims 2, 3, 5-20, 22-40 and 42-55 under 35 U.S.C. § 103 in view of Navarre and/or Miller, be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 2, 3, 5-20, 22-40 and 42-55 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance pending the submission of a Terminal Disclaimer, and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
ATH:smi

Andrew T. Harry
Registration No. 56,959